

REMARKS

Status of the Claims

Claims 1-29 are pending in the present application. In the Office Action, claims 1-3, 6-7, 10-11, 15, 18-20, 23-25, and 28-29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Corriveau, et al (U.S. Patent No. 5,918,177) in view of Streter (U.S. Patent No. 6,456,858). Claims 4-5, 13-14, and 21-22 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Corriveau in view of Streter and further in view of La Medica, et al (U.S. Patent No. 6,625,451). Claims 8-9, 16-17, and 26-27 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Corriveau in view of Streter and further in view of Lamb, et al (U.S. Patent No. 6,697,620). Claim 12 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Corriveau in view of Streter and further in view of Lamb and De Oliveira (U.S. Patent No. 6,763,004). The Examiner's rejections are respectfully traversed.

Summary of Claimed Subject Matter

Independent claims 1 and 18 set forth an apparatus and a method, respectively, for wirelessly paging a mobile device using a network operating according to multiple wireless technologies based at least in part on a technological capability of the mobile device. Claims 1 and 18 also set forth, among other things, determining whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on the accessed information and generating a paging request for the mobile device that is based at least partially on the technological capability of the mobile device when the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network. As defined in the specification, wireless technologies are the technologies used to

support wireless communications between mobile devices and networks. Wireless technologies include personal communications services (PCS) and cellular telecommunication systems. See, e.g., Patent Application, page 2, ll. 25-31. Thus, one example of a network operating according to multiple wireless technologies could be a network operating according to personal communications services (PCS) technology and cellular telecommunication technology.

Argument

A. Legal Standards

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. That is, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. Third, there must be a reasonable expectation of success.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. A recent Federal Circuit case emphasizes that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 143 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

B. Claims 1-3, 6-7, 10-11, 15, 18-20, 23-25, and 28-29 are not obvious over Corriveau in view of Streter.

Corriveau describes a mobile switching center (MSC) for wirelessly paging a mobile device based on the mobile device's expected service type. For example, some mobile devices may only be capable of receiving voice services, and not asynchronous data services and/or facsimile services. Thus, Corriveau describes modifying pages from the mobile switching centers to include service codes that indicate the service type (*e.g.* voice service, asynchronous data service, facsimile service) for the call. However, Corriveau fails to describe or suggest paging a mobile device using a network operating according to multiple wireless technologies. Furthermore, as admitted by the Examiner on page 3 of the Final Office Action, Corriveau does not describe or suggest determining whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on the accessed information. The Examiner also admits on page 3 of the Final Office Action that Corriveau fails to describe or suggest generating a paging request for the mobile device that is based at least partially on the technological capability of the mobile device when the wireless

technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network.

The Examiner relies upon Streter to describe a dual-mode wireless telephone communication system 10 that may be used for wireless communication with dual-mode wireless telephones 12. The dual-mode wireless telecommunications system 10 includes a first wireless telephone system that outputs analog telephone signals for transmission according to a first wireless protocol and a digital wireless system 20 that includes a digital base station 22 for transmission according to a digital-only transmission protocol. See Streter, col. 5, ll. 15-39 and Figure 1. The digital wireless telephone system 20 may selectively control the selection of a wireless telephone system (e.g., the analog wireless telephone system or the digital wireless telephone system) by the dual-mode wireless telephones 12. For example, the digital wireless system 20 may output a control command instructing selected dual-mode telephones to register with an alternative wireless communication system, such as an analog system. See Corriveau, col. 6, ll. 13-27 and Figure 1.

The Examiner alleges that Streter describes determining whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on the accessed information. Applicant respectfully disagrees and notes that the digital wireless telephone system 20 assumes that the dual-mode wireless telephones 12 can communicate using either the analog wireless telephone protocol or the digital wireless telephone protocol. Thus, the digital wireless telephone system 20 described by Streter does not determine whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on accessed information. Accordingly, Applicant

respectfully submits that Corriveau and Streter fail to teach or suggest all the limitations of the claimed invention.

Applicant further submits that the cited references fail to provide any suggestion or motivation to combine and/or modify the prior art to arrive at the claimed invention. Corriveau is completely silent with regard to dual-mode wireless communication systems and so provides no suggestion or motivation to combine the subject matter described in Corriveau with any of the subject matter described in Streter. Streter is completely silent with regard to the service types described in Corriveau and so provides no suggestion or motivation to combine the subject matter described in Streter with any of the subject matter described in Corriveau.

For at least the aforementioned reasons, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case that the present invention is obvious over Corriveau in view of Streter. Applicant requests that the Examiner's rejections of claims 1-3, 6-7, 10-11, 15, 18-20, 23-25, and 28-29 under 35 U.S.C. 103(a) be withdrawn.

C. Claims 4-5, 13-14, and 21-22 are not obvious over Corriveau in view of Streter and further in view of LaMedica.

As discussed above, neither Corriveau nor Streter describe or suggest determining whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on accessed information. Corriveau and Streter also fail to provide any suggestion or motivation to combine and/or modify the prior art to arrive at the claimed invention.

La Medica describes techniques for wireless telecommunication using dual-mode phones that may operate in an analog mode or a digital mode. The dual-mode phones may be used by a

subscriber to a personal communications system service provider. Alternatively, the dual-mode phones may be used by a subscriber to a cellular service provider. See La Medica, col. 7, ll. 25-26. However, La Medica is completely silent with regard to paging a mobile device using a network operating according to multiple wireless technologies. Accordingly, La Medica fails to describe or suggest determining whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on the accessed information. La Medica also fails to describe or suggest generating a paging request for the mobile device that is based at least partially on the technological capability of the mobile device when the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network.

For at least the aforementioned reasons, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case that the present invention is obvious over Corriveau in view of Streter and further in view of La Medica. Applicant requests that the Examiner's rejections of claims 4-5, 13-14, and 21-22 under 35 U.S.C. 103(a) be withdrawn.

D. Claims 8-9, 16-17, and 26-27 are not obvious over Corriveau in view of Streter and further in view of Lamb.

As discussed above, neither Corriveau nor Streter describe or suggest determining whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on accessed information. Corriveau and Streter also fail to provide any suggestion or motivation to combine and/or modify the prior art to arrive at the claimed invention. The Examiner relies upon Lamb to describe storing a user profile of the

mobile device in a Home Location Register of a mobile switching center. However, Lamb does not remedy the aforementioned deficiencies of Corriveau and Streter.

For at least the aforementioned reasons, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case that the present invention is obvious over Corriveau in view of Streter and further in view of Lamb. Applicant requests that the Examiner's rejections of claims 8-9, 16-17, and 26-27 under 35 U.S.C. 103(a) be withdrawn.

E. Claim 12 is not obvious over Corriveau in view of Streter and further in view of Lamb and De Oliveira.

As discussed above, neither Corriveau nor Streter describe or suggest determining whether the wireless technology of the mobile unit corresponds to at least one of the multiple wireless technologies of the network based on accessed information. Corriveau and Streter also fail to provide any suggestion or motivation to combine and/or modify the prior art to arrive at the claimed invention. The Examiner relies upon Lamb to describe storing a user profile of the mobile device in a Home Location Register of a mobile switching center. The Examiner also relies upon De Oliveira to describe broadcasting a page in a last cell in which the mobile device being paged was registered with the network. However, neither Lamb and or De Oliveira remedy the aforementioned deficiencies of Corriveau and La Medica.


For at least the aforementioned reasons, Applicant respectfully submits that the Examiner has failed to make a *prima facie* case that the present invention is obvious over Corriveau in view of Streter and further in view of Lamb and De Oliveira. Applicant requests that the Examiner's rejections of claim 12 under 35 U.S.C. 103(a) be withdrawn.

Conclusion

For the aforementioned reasons, it is respectfully submitted that all claims pending in the present application are in condition for allowance. The Examiner is invited to contact the undersigned at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

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